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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,875	10/13/2005	Niki S. Woodhead	1035-O5906-US	9177
69684 7590 03/31/2010 LARSON NEWMAN & ABEL, LLP 5914 WEST COURTYARD DRIVE SUITE 200 AUSTIN, TX 78730				
EXAMINER MACARTHUR, VICTOR L				
ART UNIT 3679		PAPER NUMBER		
NOTIFICATION DATE 03/31/2010		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

## Application No.

10/552,875

## Applicant(s)

WOODHEAD ET AL.

## Examiner

VICTOR MACARTHUR

## Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) 4-7 and 9-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 8, 13, 14, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 December 2009 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Restriction History***

Claims 5, 7, 11 and 12 were withdrawn for not being directed to species II, figure 4 (see office action mailed 2/13/2008) elected with traverse in the reply filed 11/29/2007.

Claims 4-7, 9-12 and 17-20 were withdrawn for not being directed to tolerance ring of Group I (see office action mailed 4/15/2009) elected without traverse in the reply filed 1/23/09.

Accordingly, the claim status is as follows:

- Claims 1-14, 21 and 22 are pending
- Claims 15-20 are canceled
- Claims 4-7 and 9-12 remain withdrawn
- Claims 1-3, 8, 13, 14, 21 and 22 are rejected

#### ***Drawings***

The drawings were received on 12/23/2009. These drawings are acceptable for entry but objected to as detailed below.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims with description by reference character in the written description or that subject matter must be deleted from the claims:

- In claim 1, “an **endmost** unformed annular portion... a guide portion contiguous with, and extending axially and radially outward from the endmost unformed annular portion” (emphasis added). Note that as shown in figure 4 the unformed annular portion closest to an end, or endmost, is at (bottom 7) however guide portion (14) is not contiguous with nor extending from (bottom 7), rather guide portion extends from (top 7). The nomenclature used in the claims must be recited in the written description with reference characters in the drawing clearly pointing out the “endmost” portion as claimed. Note that claims 8 and 21 are similarly phrased.

No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended”. If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

- The written description does not provide support for the claim 1 limitation “an **endmost** unformed annular portion... a guide portion contiguous with, and extending axially and radially outward from the endmost unformed annular portion” (emphasis added). See objection to the drawings above for further details. Note claims 8 and 21 are similarly phrased.
- The term “unformed” is misused throughout the written description and claims and should be replaced with “undeformed” or similar appropriate language. For instance take line 7 of claim 1 which states “**form** an unformed annular portion”. How can one form and unformed portion?

### ***Claim Objections***

Claims 1-3, 8, 13, 14, 21 and 22 are objected to because of the following informalities:

- The claim 1 limitation “an **endmost** unformed annular portion... a guide portion contiguous with, and extending axially and radially outward from the endmost unformed annular portion” does not accurately describe the invention as shown in the drawings (emphasis added). See objection to the drawings above for further explanation. Claims 8 and 21 are similarly phrased.

- The term “unformed” is misused throughout the claims and should be replaced with “undeformed” or similar appropriate language. For instance take line 7 of claim 1 which states “form an unformed annular portion”. How can one form and unformed portion.

Appropriate correction is required. For purposes of examining the instant invention, the examiner has assumed these corrections have been made.

*Claim Rejections - 35 USC § 112*

Claims 1-3, 8, 13, 14, 21 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- In claim 1, “an endmost unformed annular portion... a guide portion contiguous with, and extending axially and radially outward from the endmost unformed annular portion” (emphasis added). Note that as shown in figure 4 the unformed annular portion closest to an end, or endmost, is at (bottom 7) however guide portion (14) is not contiguous with nor extending from (bottom 7), rather guide portion extends from (top 7). Accordingly, it is unclear how this phraseology is meant to limit the claims.
- Note that claims 8 and 21 are similarly phrased and thus also rejected.

***Claim Rejections - 35 USC § 103***

Claims 1-3, 8, 13, 14, 16, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gutierrez USPN 6889956 in view of Cramer USPN 4981390 and Neidecker USPN 4083622.

Gutierrez discloses a tolerance ring with an end having an innermost diameter for supporting an element therein and an opposite end with an outermost diameter for supporting another element thereon. The Gutierrez outermost diameter end is shaped to flare at 90 degrees rather than being shaped as an incline as in applicant's claims.

- Both Cramer and Neidecker teach that it was extremely well known in the art for outermost diameter ends to be shaped as an incline.
- One of ordinary skill in the art (one skilled and knowledgeable enough to design, manufacture and use tolerance rings) would know that a tapered shape gives support in both axial and radial directions whereas a 90 degree flare only gives support in an axial direction. Accordingly, one of ordinary skill would conclude that the tapered end shape taught by Cramer and Neidecker would give better support than the 90 degree shaped end of Gutierrez.
- MPEP 2144.04(IV)(B) details that changes in shape have been established by case law to be obvious where there is no unexpected result (criticality) citing *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966)
- MPEP 2144 clearly states that "The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally

available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law" (emphasis added).

- MPEP 2144.04 states "If the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection" (emphasis added). However, applicant's disclosure, and all other evidence of record, fails to set forth any unexpected result due to any specific end shape over any other. Accordingly, the claimed "inclined" shape lacks any criticality such that a rejection based partly or solely on case law is appropriate.
- Note that MPEP 716.01(c )(II) states that "The arguments of counsel cannot take the place of evidence in the record". Note that MPEP 716.02 states "Evidence must show unexpected results... burden on applicant to establish results are unexpected and significant... applicants have burden of explaining proffered data... expected beneficial results are evidence of obviousness".
- "[T]he results of ordinary innovation are not the subject of exclusive rights under the patent laws. Were it otherwise patents might stifle, rather than promote, the progress of useful arts. See U.S. Const., Art. I, section 8, cl.8." In re KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007) (emphasis added). Accordingly, changing a trivial detail of the prior art (such as end shape) is at best an "ordinary innovation" if any innovation at all, and therefore does not constitute sufficient reason for patentability.



- Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the outermost diameter end to be incline shaped rather than 90 degrees shaped for the benefit of improving support to be both axial and radial (knowledge generally available as detailed above), and further since the specific end shape lacks any criticality (lacks any unexpected result as detailed above) and in accordance with the rational set forth in the MPEP sections and case law noted above.

Claims 1-3, 8, 13, 14, 16, 21, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cramer USPN 4828423 in view of Cramer USPN 4981390 and Neidecker USPN 4083622.

The rational for modification of a 90 degree end to be inclined shaped for these grounds of rejection is similar to that noted above.

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground of rejection.

### ***Conclusion***

Applicant's amendment to independent claims 1, 8 and 21, necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE**

**FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private

PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

March 30, 2010

/Victor MacArthur/  
Primary Examiner, Art Unit 3679